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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,526

09/19/2005

Peter Nesvadba

CO/21-22865/A/PCT

3612

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

05/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,526	Applicant(s) NESVADBA ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

The Status of Claims:

Claims 1-10 are pending.

Claims 1-10 are rejected.

DETAILED ACTION

1. Claims 1-10 are under consideration in this Office Action.

Priority

2. It is noted that this application is a 371 of PCT/EP04/50315(03/17/2003), which has foreign priority documents, European Patent Office (EPO) 03100790.9 (03/27/2003).

Drawings

3. None.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase " the group consisting of alkali metal, alkaline earth metal or ammonium bicarbonates and alkaline earth metal or ammonium carbonates or mixtures thereof " is recited. This expression is vague and indefinite because the closed expression of the Markush form of " the group consisting of " contains the term "or " ; this opens up the possibility for the presence of the unspecified other elements for the expression. Appropriate correction is required.

In claim 10 , the phrase " the nitroxide radical contains" is recited. This expression is vague and indefinite because the term "contains" would mean that there were additional components beside the only nitroxide radical; the skilled artisan in the art was unable to figure out what they were. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1625

Claims 1-10 rejected under 35 U.S.C. 102(b) as being anticipated clearly by Gillet et al (US 6,538,141).

Gillet et al discloses the preparation of secondary nitroxide radicals in the following example (see col. 9 , Ex. 1):

EXAMPLE 1

Preparation of (2,2,6,6-tetramethyl-piperidine) N-oxide (TEMPO)

An organic solution consisting of 5 g of 2,2,6,6-tetramethylpiperidine (i.e. 0.0354 mol) dissolved in 20 ml of dichloromethane is prepared with stirring in a 100 ml round-bottomed flask fitted with 2 dropping funnels, a condenser, a pH-measuring probe and a stirrer. 20 ml of water are then added to this solution so as to have a two-phase system. Next, 10.8 g of a 40% solution of peracetic acid 4n acetic acid and aqueous 35% by weight K_2CO_3 solution are introduced (with stirring) slowly and simultaneously. The molar amount of peracetic acid introduced is 0.0568 mol, which corresponds to a peracetic acid/amine molar ratio of 1.6.

Art Unit: 1625

The amount of aqueous K_2CO_3 solution is adjusted such that the pH of the aqueous phase of the two-phase medium is maintained at between 7.2 and 7.5 in the course of the addition.

20 minutes after the addition, the total disappearance of the amine and the formation of TEMPO are found by gas chromatography (GC).

The reaction is stopped and K_2CO_3 solution is added so as to obtain a pH equal to 9, and the red-colored TEMPO is then extracted with CH_2Cl_2 .

Evaporation of the solvent gives 4.9 g of TEMPO with a melting point equal to $36^\circ C$. The purity of the TEMPO is checked by GC relative to a sample of pure product (purity greater than 99%) sold by the company Aldrich.

Mass spectrum (m/e): 157 (M+1)

The yield of TEMPO relative to the amine used is 88%.

This is identical with the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Taylor Victor Oh, MSD,LAC
Primary Examiner
Art Unit :1625

/Taylor Victor Oh/
Primary Examiner, Art Unit 1625
5/1/08